

## REMARKS/ARGUMENT

Claims 1-12 were pending. Claims 1-5 have been canceled. Claims 6, 7, 9, and 11 have been amended for clarity. Accordingly, claims 6-12 presently are pending.

Claims 1-12 have been rejected under 35 U.S.C. § 112, second paragraph, on the basis of indefiniteness. The claims presented have been amended to address the Examiner's §112 concerns. The claims are submitted as particularly pointing out and distinctly claiming the subject matter of the invention.

Claims 1-5 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,736,218 to Iwata et al. Claims 1-5 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,129,871 to Suzuki et al. Claims 1-5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 06198610 in view of WO 95/05275. Claims 1-5 no longer are pending in the present application.

Claims 6-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 61066604 in view of WO 95/05275. Applicants respectfully traverse the rejection.

The present invention as recited in amended claim 6 is a method for manufacturing ligneous material in which first wood elements are acetylated with a first degree of acetylation, and second wood elements are optionally acetylated with a second degree of acetylation. The first degree of acetylation measured in weight percent gain is 7% or greater and the second degree of acetylation is less than the first degree of acetylation. Third wood elements are bonded with a binder containing polyisocyanate. The third wood elements consist of a first amount of the first wood elements and a second amount of the second wood elements, such that the average degree of acetylation measured in weight percent gain of the third wood elements is 7% or greater.

In contrast to the present invention as recited in amended claim 6, JP '604 discloses boards prepared with wood chips acetylated to 15-20% of total OH groups in the chips. JP '604 does not teach or suggest controlling the acetylation degree of wood chips based on weight gain. Further, JP '604 does not teach or suggest controlling acetylation based on a change in weight of 7% or more. Applicants note that for a given amount of acetylation, the percentage of acetylated

hydroxyl groups is not equivalent to the percentage of weight gain. Accordingly, claim 6 is not anticipated or rendered obvious by JP '604.

WO '275 does not cure the deficiencies of JP '604. WO '275 has been cited for use of a binder for preparing a wood composite. WO '275 does not teach or suggest acetylation of wood elements. Thus, WO '275, taken alone or in combination, does not anticipate or render obvious the present invention as recited in amended claim 6.

Claim 6, and its dependent claims 7-12, respectfully are submitted as being patentable over the cited prior art.

The application is submitted as being in condition for allowance.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'P. McGee', is written over a horizontal line.

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**APPENDIX A**  
**"CLEAN" VERSION OF EACH PARAGRAPH/SECTION/CLAIM**  
**37 C.F.R. § 1.121(b)(ii) AND (c)(i)**

**CLAIMS:**

Sub B 1 7  
5 A 1 6. (Amended) A method for manufacturing ligneous material, comprising the steps of:  
preparing a first wood elements which are acetylated with a first degree of acetylation, and a  
second wood elements which are optionally acetylated with a second degree of acetylation,  
wherein said first degree of acetylation measured in weight percent gain is 7% or greater and said  
second degree of acetylation is less than said first degree of acetylation; and binding a third wood  
elements with a binder containing polyisocyanate, wherein the third wood elements comprises a  
first amount of said first wood elements and a second amount of said second wood elements,  
wherein the average degree of acetylation measured in weight percent gain of said third wood  
elements is 7% or greater.

7. (Amended) A method for manufacturing ligneous material according to claim 6,  
wherein said first wood elements are acetylated by placing a wood elements in a gas or liquid  
which contains acetyl groups.

A2 Sub B 3 7 9. (Amended) A method for manufacturing ligneous material according to claim 6,  
wherein said average degree of acetylation measured in weight percent gain of said third wood  
elements is 7 to 18%.

A3 Sub B 3 7 11. (Amended) A method for manufacturing ligneous material according to claim 6,  
wherein said binder contains polymeric 4,4'-diphenylmethane diisocyanate.

## APPENDIX B

### VERSION WITH MARKINGS TO SHOW CHANGES MADE

37 C.F.R. § 1.121(b)(iii) AND (c)(ii)

#### CLAIMS:

5 6. (Amended) A method for manufacturing ligneous material, comprising the steps of: preparing a first wood elements which are acetylated with a first degree of acetylation, and a second wood elements which are optionally acetylated with a second degree of acetylation, wherein said first degree of acetylation measured in [( ) weight percent gain ( )] is 7% or greater and said [said] second degree of acetylation is less than said first degree of acetylation; and binding a third wood elements with a binder containing polyisocyanate, wherein the third wood elements [consist of] comprises a first amount of said first wood elements and a second amount of said second wood elements, wherein the average degree of acetylation measured in weight percent gain of said third wood elements [(weight percent gain)] is 7% or greater.

7. (Amended) A method for manufacturing ligneous material according to claim 6, [further comprising a step of;] wherein [acetylating] said first wood elements are acetylated by placing a wood elements in a gas or liquid which contains [containing] acetyl groups [to obtain said first wood elements].

9. (Amended) A method for manufacturing ligneous material according to claim 6, wherein said average degree of acetylation measured in weight percent gain of said third wood elements [(weight percent gain)] is 7 to 18%.

11. (Amended) A method for manufacturing ligneous material according to claim 6, wherein said binder [containing] contains polymeric 4,4-diphenylmethane diisocyanate [MDI].